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10/763,610	01/24/2004	Karan Mari Hintze	2401-pa	7265

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EXAMINER

REESE, DAVID C

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 04/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/763,610

Applicant(s)

HINTZE, KARAN MARI

Examiner

David C. Reese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 18-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-20 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

- [1] Claims 1-20 are pending.

Claim Objections

- [2] Claim 19 is objected to because it includes a reference character, 10, which is not enclosed within parentheses.

Reference characters corresponding to elements recited in the detailed description of the drawings and used in conjunction with the recitation of the same element or group of elements in the claims should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. See MPEP § 608.01(m).

Claim Rejections - 35 USC § 102

- [3] The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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[4] Claims 1-16, 18-20 are rejected under 35 U.S.C. 102(b) as clearly anticipated by Prussian, US- 1,864,371, because the invention was patented or described in a printed publication in this or a foreign country, or in public use or on sale in this country more than one (1) year prior to the application for patent in the United States.

As for Claim 1, Prussian teaches of an article of jewelry comprising in combination:

a casing (14 in Fig. 4) having an encompassing sidewall (22) defining a hollow casing interior, said sidewall (22) having an upper peripheral end transitioning into a top (14) with an opening therein leading to said hollow casing interior (18 in Fig. 2) and said sidewall (22) further including a bottom peripheral edge (24 in Fig. 2) defining an opened bottom end (26 in Fig. 2) in open communication with said hollow casing interior (14 in Fig. 2);

a rotating gem retaining means (32 in Fig. 2) at least partially received within said hollow interior of said casing (30 in Fig. 4) and including an upper portion (30') for securely retaining a gem (28) having a pavilion and a crown with its crown being visible through said opening of said top of said casing (28 in Fig. 4),

said rotating gem retaining means (32) further including a lower portion (34) comprised of an elongated member having an upper end (top of 34) operatively coupled to a bottom of said upper portion of said gem retaining means (32) and axially extending away from said gem retaining means and terminating into a tapered lower end (bottom of 34, 38);

a plurality of radially extending protrusions (30') operatively coupled to said gem retaining means (32) at a location proximate a bottom surface of said top of said casing (14);

a bottom member (36) operatively coupled across said opened bottom end (26) of said casing (14) and having an upper surface with a notch (inside of 36, threads as shown in Fig. 2)

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formed therein for rotatably receiving said tapered tip of said elongated member (bottom of 34, 38) therein and for rotatably biasing said plurality of radially extending protrusions (30') with said bottom surface of said top of said casing for rotatably setting the gem retaining means (32) and gem (28) for providing gem rotation (via 34 against the inside of 36) visible through said opening in said top of said casing (inside of 14) and in response to movement by a wearer of an article of jewelry comprised of said rotatable setting device.

Re: Claim 2, wherein said upper portion of said gem retaining means is comprised of a plurality of prong members (30') including at least one pair of substantially diametrically opposed prong members having a first prong member substantially diametrically opposed to a second prong member (30', 30' in Fig. 2).

Re: Claim 3, further including a pair of weighted members (30, 32 in Fig. 2) including a first weighted member (30 in Fig. 2) operatively coupled to said first prong member (30' in Fig. 2) and a second weighted member (32 in Fig. 2) operatively coupled to said second prong member (30' in Fig. 2) for defining a pair of substantially diametrically opposed weighted members (30, 32 in Fig. 2).

The following is an example of intended use, as the statement does not further limit the structure of the claimed invention: "working in combination with gravity and movement of said jewelry article by the wearer for providing gem rotation visible through said opening in said top of said casing".

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re: Claim 4, further including at least one weighted member (30, 32 in Fig. 2) operatively coupled to said upper portion of said gem retaining means (30').

The following is an example of intended use, as the statement does not further limit the structure of the claimed invention: "and working in combination with gravity and movement of said jewelry article by the wearer for providing gem rotation visible through said opening in said top of said casing".

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re: Claim 5, wherein said casing (14) has an integral interior rim (18) surrounding said top opening (14), said rim (18) having a bottom surface defining a raceway (18) against which said protrusions (30') are rotatably biased with during gem rotation (insertion, removal of gem) due to said at least one weighted member (32).

The following is an example of intended use, as the statement does not further limit the structure of the claimed invention: "working in combination with gravity and movement of said jewelry article by the wearer for providing gem rotation visible through said opening in said top of said casing".

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re: Claim 6, wherein said bottom surface of said rim (18) is recessed upwardly forming a curved protrusion in a top surface (18) of said top of said casing (14) which circumscribes said top opening.

Re: Claim 7, wherein said top surface of said top of said casing is decorative (14 in Fig. 1).

Re: Claim 8, wherein said gem retaining means (32) is comprised of a base (bottom of 32, before 34) and a plurality of prong members (30') defining a prong setting, said base defines a central region with a central axis running therethrough (bottom of 32, before 34) and said prong members (30') having spaced apart lower ends integrally formed with said base member (bottom of 32, before 34) and upwardly extending from said base member in a spaced apart relationship with respect to one another and at an angle with respect to the central axis of the base member (Fig. 2) and terminating into radiused upper ends such that said plurality of prong members (30') are arranged about the central axis to correspond with gem shape.

Re: Claim 9, wherein each of said plurality of prong members includes a notch (between 30 and 30' in Fig. 2) located on an interior side of said upper ends of said plurality of prong members (32) for operatively mating with a girdle of the gem (28) for providing secure gem retention.

Re: Claim 10, wherein said elongated member (34) is integrally formed with said base member (top of 34, bottom of 32) at said upper end and axially extends away from an underside of said base member along the central axis and terminates into said tapered lower end (bottom of 34, 38 in Fig. 2).

Re: Claim 11, wherein said bottom member is comprised of an elongated bar member (36) operatively coupled across said opened bottom end of said casing (26) such that light can shine through the pavilion of the gem (28) via the opened bottom end of the casing (inside of 14) for dispersion viewing through the crown and wherein said elongated bar member (36) includes

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said notch (inside of 36, threads) formed therein for rotatably receiving said tapered tip (bottom of 34, 38) of said elongated member (34) therein and for rotatably biasing said plurality of protrusions (30') against said bottom surface of said rim (18) of said casing (14) for providing gem rotation in response to movement of said jewelry article by a wearer (insertion, removal of gem).

As for Claim 12, Prussian teaches of an article of jewelry comprising:

a rotating gem retaining means (32) comprised of a base (bottom of 32), a plurality of spaced apart prongs members (30') connected to and upwardly extending away from said base (34) for securely retaining a gem (28) having a pavilion and a crown;

said rotating gem retaining (32) means further comprised of an elongated member (34) connected to and downwardly extending away from said base (bottom of 32) and terminating into a tapered lower tip (end of 34, 38);

a casing (14) having an encompassing sidewall (22) circumscribing said rotating gem retaining means (32) and defining a hollow casing interior (inside of 22), said sidewall (22) having an upper peripheral end transitioning into a top (14) with an opening therein leading to said hollow casing interior (inside of 22) such that the crown of the gem (28) is visible through said opening of said top of said casing (14) and said sidewall (22) further including a bottom peripheral edge defining an opened bottom end in open communication with said hollow casing interior (24);

a plurality of protrusions (30') operatively coupled to said plurality of spaced apart prong members (30) and axially extending away from said plurality of spaced apart prong members at a location proximate a bottom surface of said top of said casing (30' against 14 in Fig. 4);

said plurality of spaced apart prong members (30) including at least one pair of substantially diametrically opposed prong members comprised of a first prong member and a second prong member (30', 30' in Fig. 2);

a pair of weighted members (30, 32) including a first weighted member (30') operatively coupled to said first prong member (30') and a second weighted member (32) operatively coupled to said second prong member (30') for defining a pair of diametrically opposed weighted members,

a bottom member (36) operatively coupled across said opened bottom end (24) of said casing (14) and having an upper surface with a notch (inside of 36) formed therein for rotatably receiving said tapered tip (bottom of 34, threads, 38) of said elongated member (34) therein and for rotatably biasing said plurality of protrusions (30') against said bottom surface of said top of said casing (inside of 14) for rotatably setting the rotating gem retaining means (insertion, removal of gem) and gem (28)

The following is an example of intended use, as the statement does not further limit the structure of the claimed invention: "working in combination with gravity and movement of said jewelry article by the wearer for providing gem rotation visible through said opening in said top of said casing".

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re: Claim 13, wherein said casing (14) has an integral interior rim (18) surrounding said top opening (14), said rim (18) having a bottom surface defining a raceway (18) against which

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said protrusions (30') are rotatably biased with during gem rotation (insertion, removal of gem) due to said at least one weighted member (32).

The following is an example of intended use, as the statement does not further limit the structure of the claimed in invention: "working in combination with gravity and movement of said jewelry article by the wearer for providing gem rotation visible through said opening in said top of said casing".

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re: Claim 14, wherein said bottom surface of said rim (18) is recessed upwardly forming a curved protrusion in a top surface (18) of said top of said casing (14) which circumscribes said top opening.

Re: Claim 15, wherein said sidewall (22) of said casing (14) includes at least one opening (to the left and right of 22 in Fig. 2) extending therethrough for allowing light to pass into said hollow interior of said casing.

Re: Claim 16, wherein said sidewall (22) of said casing (14) tapers from top to bottom providing a top diameter that is larger than a bottom diameter of said casing (14 compared with 24 in Figs. 2 and 4).

Re: Claim 18, wherein said protrusions are radially outwardly and axially upwardly extending appendages (30').

As for Claim 19, Prussian teaches of a method for making a rotatable setting device for jewelry, the steps including:

providing a hollow casing (14) having an encompassing sidewall (22) defining a hollow casing interior (inside of 22), the sidewall (22) having an upper peripheral end transitioning into a top (14) with an opening therein leading to the hollow casing interior (inside of 14) and the sidewall (22) further including a bottom peripheral edge defining an opened bottom end (24) in open communication with the hollow casing interior (inside of 22);

providing a rotating gem retaining means (32) comprised of a base (below 32), a plurality of spaced apart prongs members (30) upwardly extending away from the base (below 32) for securely retaining a gem (28) having a pavilion and a crown, and an elongated member (34) downwardly extending away from the base (below 32) and terminating into a tapered lower tip (bottom of 34, 38);

inserting the rotating gem retaining means (32) through the opening in the top of the casing (14) and positioning at least a portion of the rotating gem retaining means within the interior of the casing (30' into 14) such that upper portions of the plurality of prong members (30) protrude through the opening in the top of the casing (14) to an exterior of the casing;

retaining the positioning and marking each of the plurality of spaced apart prongs (30) members to which a protrusion (30') is to be attached at a location directly underneath an underside of the top of the casing (14) proximate the opening in the top (14) and then removing the rotating gem (28) retaining means from the casing (14),

coupling a protrusion (30') to each marked prong (30) at approximately each marked location,

coupling at least one weighted member (30, 32) to at least one of the plurality of the prong members (30') below each coupled protrusion (30');

inserting the rotating gem retaining means (32) through the opened bottom end and into the hollow casing interior (inside 14, 22) such that the upper portions of the plurality of prong members (30) protrude through the opening in the top of the casing (14) to the exterior of the casing;

providing a bottom member (36) having an upper surface with a notch (inside of 36, threads) formed therein for rotatably receiving the tapered tip of the elongated member (34) therein;

coupling the bottom member (36) across the opened bottom end of the casing (14, 24) making sure that the tapered tip of the elongated member (bottom of 34, 38) is rotatably received within the notch (inside of 36, threads) of the bottom member (Fig. 4) and that each coupled protrusion (30') is spaced from the under side of the top of the casing (14) proximate the opening for rotatably setting the gem retaining means (32) and gem (28)

“for providing gem rotation in response to gravity on at least the weighted means and movement of an article of jewelry comprised of the rotatable setting device 10 (see claim objections) by the wearer for providing gem rotation visible through the opening in the top of the casing”

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Re: Claim 20, wherein the step of coupling at least one weighted member to at least one of the plurality of the prong members below each coupled protrusion includes the step of coupling a pair of weighted members (30, 32) including a first weighted member (30) operatively coupled to one of the plurality of prong members (30') and a second weighted

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member (32) operatively coupled to another substantially diametrically opposed prong members (30') for defining a pair of substantially diametrically opposed weighted members.

The following is an example of intended use, as the statement does not further limit the structure of the claimed invention: "working in combination with gravity and movement of said jewelry article by the wearer for providing gem rotation visible through said opening in said top of said casing".

It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Allowable Subject Matter

[5] Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

As for Claim 17, the prior art, incorporating other corresponding limitations as set forth above, does not teach protrusions that are cylindrical balls.

Conclusion

[6] The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


The following patents are cited further to show the state of the art with respect to this particular type of setting; as well as their extreme relevance to the current application as many read extensively onto the claimed invention: please see submitted notice of reference cited.

[7] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (571) 272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,
David Reese
Examiner
Art Unit 3677



ROBERT J. SANDY
PRIMARY EXAMINER